IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of Southern California	)	Opposition No.: 125,615
Opposer,	)	Serial No.: 75/358,031
vs.	)	Mark: "SC" (Stylized)
University of South Carolina,	)	
Applicant.	)	

11-14-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO MOTION TO COMPEL

The applicant, University of South Carolina ("Carolina"), hereby submits this reply in response to the brief recently filed by the opposer, University of Southern California, ("California"), relating to Carolina's Motion to Compel.

I. The agreed upon stipulation did not prohibit a Motion to Compel.

In its Response, California argues that Carolina's Motion to Compel should be disallowed based upon the consent stay of discovery which existed between the parties. However, by agreeing to the stay, Carolina did not simply forfeit its right to receive discovery responses from California prior to a Motion for Summary Judgment being determined. As stated in its initial Motion to Compel, Carolina served its Interrogatories and Requests for Production on California in July of 2002. Despite such service, California neglected to respond to Carolina's discovery even after it came due once California filed its Motion to Dismiss in October of 2002. However, once California's Motion to Dismiss was decided, Carolina's outstanding discovery was still effective and California's responses remained overdue.

In good faith, both sides agreed to the temporary stay of discovery in an effort to attempt to settle the case in September of 2003. However, that agreement did not simply discharge California's existing burden to respond to Carolina's discovery after the expiration of the stay on October 15th. Obviously, it was not Carolina's intention that its right to responses to affirmative discovery would essentially be lost by agreeing to the stay.[1]

Further, despite any arguments to the contrary, the stay of discovery had no impact on either party's rights to file motions in this case other than the Motion for Summary Judgment which was expressly mentioned in the text of the stay. Recognizing this fact, Carolina's Motion to Compel explicitly acknowledged that its Motion was being filed prior to the expiration of the stay of discovery. Certainly, by filing its motion at the end of the stay, Carolina did not intend for California to be forced to answer discovery prior to the expiration of the stay. However, Carolina filed the Motion to Compel to preserve its rights to receive responses from California. The discovery stay has now expired and California should therefore be compelled to answer discovery prior to a determination of the summary judgment motion.

In its Response, California goes to great lengths to allege that Carolina did not confer in good-faith to resolve the present dispute. On the contrary, counsel for Carolina certifies that they have had multiple conversations regarding this discovery. The first such conversation occurred when, after filing its Motion to Dismiss, counsel for California told counsel for Carolina that it would withhold its responses pending the determination of that Motion. As

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Carolina was under the impression that one of the main reasons for the stay was to grant California an extension of time on responding to Carolina's already outstanding and overdue discovery. It is odd for California, after agreeing to the stay of discovery, to now contend that Carolina's discovery is somehow moot. If that was truly California's belief, it makes their original willingness to enter into such a stay very difficult to comprehend.

documented by its letter which was attached as Exhibit B to its Response brief, California felt that it did not need to respond to Carolina's discovery despite the fact that it had been overdue. Since that time, the topic of the responses has been raised on several other occasions. It should be undisputed that the parties have discussed responses to this discovery on several occasions and cannot agree as to California's rights and duties. The briefing on this Motion to Compel provides further cumulative evidence that the parties are in total disagreement over California's need to respond to discovery since, for whatever reason, California repeatedly classifies Carolina's discovery as being irrelevant and unnecessary.

Additionally, California ridiculously asserts that the Motion to Compel will not affect the Board's determination of the summary judgment motion. It is ludicrous for California to allege that discovery specifically relating to goods, services, channels of trade, priority of use, and familiarity of their mark is not directly relevant to the pertinent issues in their summary judgment motion. Indeed, California's main assertion in its Motion for Summary Judgment is that a likelihood of confusion exists between the marks at issue. Carolina's discovery directly relates to this contention. Despite all assurances from its adversary, Carolina believes it is entitled to view responses to its sixteen month old discovery to evaluate for itself whether California's responses will be relevant to its summary judgment arguments.

II. Carolina is entitled to discovery responses

In its Response, California mischaracterizes Carolina's rationale for filing this Motion to Compel. Specifically, California alleges that, "The only purpose of filing this motion during the discovery stay would be to provide a possible support for the invocation of F.R.C.P. 56(f) in connection with California's summary judgment motion." **California Response brief, p. 2**. On the contrary, there is a much more straightforward rationale behind

Carolina's filing of this motion. Simply put, Carolina seeks (and is clearly entitled to) responses to discovery which it served more than a year ago.

At this point, Carolina believes that enough clear factual disputes already exist to defeat California's Motion for Summary Judgment. However, California does not have the privilege of simply disregarding Carolina's outstanding affirmative discovery prior to having its Motion for Summary Judgment heard. The TMBP specifically provides for a stay of discovery in the event that a Motion to Compel is filed and Carolina is entitled to such a stay at this point under 37 C.F.R. § 2.120 to allow it to view California's responses prior to a determination of the pending Motion for Summary Judgment. *See e.g. Giant Food Inc. v. Standard Terry Mills, Inc.*, 1986 TTAB LEXIS 96, *40 (TTAB held that, under the facts of the case, a "motion for Summary Judgment does not constitute good cause for not timely responding to. . . outstanding discovery requests")

CONCLUSION

It is obvious that California simply does not want to answer Carolina's discovery at this point. Its reasons are obvious. California knows that if it fully answers Carolina's discovery as it should have done months ago, it will only provide further support for Carolina's position that factual issues sufficient to defeat California's Motion for Summary Judgment clearly exist. As stated in its initial Motion to Compel, Carolina filed this motion to preserve its rights to receive discovery responses because it anticipated that California would attempt to have its Motion for Summary Judgment heard prior to filing its responses. However, Carolina requests through its Motion to Compel that the Board stay the proceedings and force California to respond to Carolina's affirmative discovery which was served approximately fifteen (15) months ago.

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11/11, 2003

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513.

Cis Burris

Cis Burris

Date: 11/11/2003

CERTIFICATE OF SERVICE

I, the undersigned Administrative Assistant of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for Applicant, do hereby certify that I have served all counsel in this action with a copy of the pleading(s) hereinbelow specified by mailing a copy of the same by United States Mail, postage prepaid, to the following address(es):

Pleadings:

APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO MOTION TO COMPEL

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November 11, 2003

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November 11, 2003

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NO FEE
Assistant Commissioner for Trademarks
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RE: University of Southern California v. University of South Carolina
Our File No.: 13524/01501

Dear Assistant Commissioner:

Please find enclosed the **Applicant's Reply to Opposer's Response to Motion to Compel** in the above-referenced matter. By copy of this letter we are serving the opposing counsel.

Thank you for your assistance in this matter.

Very truly yours,

Matthew D. Patterson

Enclosures

cc: Walter H. Parham (w/ encl.)
Scott A. Edelman (w/ encl.)
Michael S. Adler (w/ encl.)